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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/217,595 12/22/98 LANIER

J 5181-10802

EXAMINER

LM21/0201

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ART UNIT/REAT, W PAPER NUMBER

DATE MAILED: 02/01/00

12  
02/01/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

69/217,595

Applicant(s)

Lanier et al

Examiner

W. TREAT

Group Art Unit

2743

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 (three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/10/00.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-94 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-94 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Claims 1-94 are presented for examination.
2. Claims 1-94 are rejected under 35 U.S.C. 251 as being drawn to subject matter voluntarily given up by applicants in order to obtain a patent.
3. A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1989); In re Wadlinger, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 363-64 (CCPA 1969); In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The Federal Circuit stated the following principles in Clement: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. See MPEP § 1412.03 as to broadening claims
4. Applicants' independent claims 31, 66, 72, and 77 and their dependents as well as new independent claims 90 and 94 and their dependents are an attempt to recapture subject matter of

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claim 1 which was deliberately amended (i.e. canceled) by applicants following a rejection by the examiner based on prior art. Even though applicants' claims might be viewed as narrower in an aspect of the claims unrelated to the prior art rejection they are broader in aspects germane to the prior art rejection. For instance, when applicants use words such as "emulate the first body..." and emulate the second body..." these words are directed to the same aspect of applicants' invention as the "first body emulating means..." and second body emulating means..." described in a far more limiting manner following amendment of claim 1 after the examiner's prior art rejection. Also, applicants' switch from means plus function language to describe sensing and integrating aspects of applicants' invention to broader terms is also viewed as an attempt to recapture. Applicants' new claims 90-94 are also broader in aspects germane to the prior art rejection.

5. Applicants' mistakes of a typographical or clerical nature were more appropriate to a Certificate of Correction than a reissue application.

6. Claims 1-30 will not become allowable unless applicants amend the new independent claims so that they are commensurate in scope with all aspects of the appropriate, previously allowed independent claims before further amending the claims to correct for any failure to file, for example, for a software program on a computer-readable medium. Should applicants merely cancel their new claims or fail to present allowable claims which correct errors other than those of a typographical or clerical nature they will have failed to demonstrate an error meriting reissue and all claims will stand rejected.

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7. Applicants have made an interesting argument that only claim features which applicants argue as distinguishing their claims over the art may be considered when determining aspects germane to the prior art rejection. Under applicants' interpretation if an applicant filed a one line claim which was then rejected over prior art followed by applicants submitting a forty page claim with a simple statement that they believed the claim to now be allowable, then should the examiner allow that forty page claim, there would be no germane aspects for the examiner to consider upon reissue because the applicants had argued no aspects of the invention. This is preposterous. The correct interpretation is that the final language of the allowed claim is the determinant of what is germane. Applicants need have included no feature in their claims which was not necessary to either meet the requirements of the patent laws or distinguish over the prior art. Reissue is not a forum to second guess applicants' previous judgement of what claim language changes were necessary to overcome the prior art.

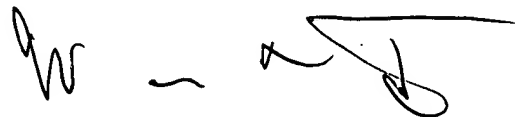
8. Applicants have also argued a reinterpretation of relevant case law based on a reading of only carefully selected portions of the case law. The examiner is not persuaded by these arguments and refers applicants to the principles cited in the Federal Circuit's 1997 Clement decision which set out how one determines when claims are an attempt to recapture subject matter. The examiner still believes these principles cited in paragraph 3, *supra*, to represent the currently prevailing opinion of the courts.

9. Since the examiner sent the wrong cover sheet with his rejection which indicated some claims were allowable when all claims had been rejected, the examiner is giving applicants'

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another opportunity to correct their claims. However, since applicants' claims have been twice rejected, they may also proceed to appeal.

10. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (703) 305-9699.

A handwritten signature in black ink, appearing to read 'W. M. Treat', with a long horizontal line extending from the end of the signature.

**WILLIAM M. TREAT  
PRIMARY EXAMINER**